Appln. No. 09/991,096
Amendment dated May 2, 2005
Reply to Office Action mailed January 31, 2005

REMARKS

Reconsideration is respectfully requested.

Claims 1 through 24 remain in this application. No claims have been cancelled. No claims have been withdrawn. Claims 25 through 34 have been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraph 2 of the Office Action

Claims 8 and 11 have been objected to for the informalities noted in the Office Action.

Claim 11 has been amended to depend from claim 10, and therefore claim 11 is submitted not be a duplicate of claim 8.

Withdrawal of the objection to claims 8 and 11 is therefore respectfully requested.

Paragraph 3 of the Office Action

Claims 8 and 11 have been rejected under 35 U.S.C. §112 (second paragraph) as being indefinite.

The above amendments to the claims are believed to clarify the requirements of the rejected claims, especially the particular points identified in the Office Action.

Withdrawal of the §112 rejection of claims 8 and 11 is therefore respectfully requested.

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Paragraphs 5 through 7 of the Office Action

Claims 1 through 24 have been rejected under 35 U.S.C. §102(b) as being anticipated by Goldband et al. (U.S. Patent Number 6,434,532, hereinafter referred to as "Goldband").

Claim 1, particularly as amended, requires "a user information handling system capable of detecting and uploading data related to the user's interaction with the user information handling system *during an initial setup of the user information handling system*" (emphasis added). Further, claim 10, which has not been amended, requires "a user information handling system capable of detecting and uploading data related to the user's out-of-box interaction with the user information handling system *during initialization*" (emphasis added). Claim 12 requires "*initializing* the user information handling system including user interaction detecting capability, by the user" and "detecting data related to *the user's interactions with the information handling system during initialization*" (emphasis added). Claim 20 requires "detecting an initialization of a user when the user sets up a user information handling system", "*saving the initialization activity* detected in said detecting step to a file", and "uploading the file to an originator of the user information handling system wherein the initialization activity of the user is correlated by the originator" (emphasis added). Claim 22 requires "a second software program capable of causing the user information handling system to *detect and compile the user's initial interactions with the information handling system* performing the first software program" (emphasis added). Claim 23 requires "means for detecting an *initialization activity* of a user when the user initializes an information handling system" and "means for *saving the initialization activity* detected by said monitoring means to a file" (emphasis added).

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In the Office Action, the Goldband patent is relied upon in rejecting all of the claims of the present patent application. Several portions of the Goldband patent are cited, including at col. 2, lines 3 through 6, which state (emphasis added):

> The agent, <u>with the user's informed consent</u>, gathers activity information about the operations of the software program(s) and uploads this information to a particular server machine within a distributed server machine architecture, where it is stored in a database on a per-software-copy basis.

The Goldband patent is further cited at col. 1, lines 56 through 61, which state (emphasis added):

> The present invention, generally speaking, provides for broad-based, systematic, individualized, interactive customer software support through a two-way, <u>voluntary</u> automated exchange of information between a software agent installed on a customer's machine and a server machine via a wide area computer network, e.g., the Internet.

However, it is submitted that neither of these portions of the Goldband patent teach, or suggest, the ability to detect and upload the user's "the user's interaction with the user information handling system during an initial setup of the user information handling system". Instead, it is submitted that one of ordinary skill in the art, considering the statements in Goldband, would be more likely to understand that the Goldband system does not detect and upload information related to the initial setup or initialization of a system. In particular, the Goldband patent is clear about the feature of the system that participation is voluntary, which lead one of ordinary skill in the art to believe that data about initialization activities are not detected. See, for example, the portions of the Goldband patent cited in the rejection that are reproduced above, which clearly emphasize that participation is voluntary. The process for providing such informed consent is set forth in Goldband at col. 3, lines 11 through 22:

Communications between the agent and the server are voluntary. In an exemplary embodiment, when the agent is first activated on behalf of a particular application, it displays to the user a preferred customer enrollment screen display such as that of FIG. 2. By clicking on the appropriate button, the user may accept or decline to participate in the preferred customer program. If the customer accepts, then the customer enters into an invited relationship with the software vendor and agrees to the software vendor maintaining personalized information about the configuration and use of the application in order to provide individualized service.

It is submitted that the Goldband patent does not disclose any collection of information before consent is given through the enrollment display screen, and it is submitted that there is no suggestion in Goldband that the enrollment display screen is displayed prior to an initialization process for the system. However, if the enrollment display screen is not displayed until after the initialization of the system by the user, and the Goldband system does not collect any information prior to the giving of consent, it is submitted that the Goldband patent is incapable of suggesting to one of ordinary skill in the art that such information is collected during initialization.

It is noted that, while the participation in the claimed system may or may not be voluntary, the claimed invention does not require any consent before detecting information about the initialization, and may, for example, obtain consent at the time of purchase (and thus before the initialization--see the present application at page 9, lines 2 through 3), or may obtain consent after the initialization process (but after the data has been detected--see the present application at the last paragraph of page 8).

It is therefore submitted that the Goldband patent would not lead one of ordinary skill in the art to the applicant's claimed invention as defined in claims 1, 10, 12, 20, 22, and 23, especially with the requirements set forth above, and therefore it is submitted that these

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claims are allowable over the prior art. Further, claims 2 through 9, 11,
13 through 19, 21, and 24, which depend from these claims, also include
the requirements discussed above and therefore are also submitted to be in
condition for allowance.

With respect to claim 13, which requires "offering an incentive to
upload user interaction data", the rejection of the Office Action cites the
Goldband patent at col. 2, lines 3 through 6, which states:

> The agent, with the user's informed consent, gathers activity
> information about the operations of the software program(s) and
> uploads this information to a particular server machine within a
> distributed server machine architecture, where it is stored in a
> database on a per-software-copy basis.

However, this portion of the Goldband patent does not mention anything
about providing the user with an incentive to "upload user interaction
data", as required by claim 13, and further inspection of the disclosure of
the Goldband patent fails to suggest this feature of the claimed invention.
It is therefore submitted that claim 13 defines over the prior art.

Claim 18 requires "surveying the user about information regarding
at least one of demographic data and user opinion", and claim 19 further
requires "correlating survey information with user interaction data". The
rejection of the Office Action states that the feature required by claim 19
is taught by the Goldband patent at col. 8, lines 4 through 10, which
states:

> The system also has the ability to determine who among the vendors.
> installed base will see a particular message. Criteria can be based on
> demographics, responses to past offers, responses to past surveys,
> usage information, time since the application was installed, even
> random selection.

While this portion of the Goldband patent mentions the use of survey
results to determine which vendors will receive a message, but fails to
mention anything about correlating any survey information with user

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interaction data. It is therefore submitted that the Goldband patent would not lead one of ordinary skill in the art to the claimed invention required by claim 19.

Claim 21 requires "the step of correlating the initialization activity of the user, determining whether a change in the initialization is needed, and, in the event a change is needed, *modifying an initialization process for new information handling systems* in response to the analyzed initialization activity of the user" (emphasis added). Similarly, claim 24 requires "the originator correlates the initialization activity of the user so that a *future system can be configured* in response to the correlated initialization activity of the user" (emphasis added). The rejection of claim 21 in the Office Action refers to the Goldband patent at col. 2, lines 10 through 16, which states (emphasis added):

> Based on these instructions, the agent may take any of various actions, such as present a survey, present an advertisement, send an upgrade notice, present a limited-time offer, deliver individualized marketing messages, offer goods for sale and fulfill the commercial transaction, install an upgrade or bug fix for either an application or the agent itself, etc.

It is submitted that one of ordinary skill in the art, considering this portion of the Goldband patent, would understand that the Goldband system may attempt to *install,* on the system on which the agent is located, an upgrade or a bug fix, but there is nothing here that suggest that "a user's "initialization activity" might be used to modify an initialization process on new information handling systems, as it appears clear that the Goldband system is directed to attempting to "fix" the system from which the agent is sending information. Further, since the initialization activity likely occurs only once on a system, the actions described by Goldband would tend to lead one of ordinary skill in the art away from the claimed invention, since Goldband clearly is directed at

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fixing future operations of *that* system, and the requirements of claim 21 are directed to the initialization activities of other systems.
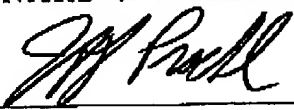
Withdrawal of the §102(b) rejection of claims 1 through 24 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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